

## REMARKS

### **I. Introduction**

The following issues are outstanding in the present Office Action:

- Claims 66-69 stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.
- Claims 1-5, 7-14, 16-22, 26-41, 44-50, 52-63, 65 and 66-73 stand rejected under 35 U.S.C. § 103 as being unpatentable over U.S. Patent No. 6,237,145 to Narasimhan (hereinafter *Narasimhan*) in view of Official Notice.

Applicant traverses these rejections and requests reconsideration in light of the amendments and remarks contained herein. Claims 1-5, 7-14, 16-22, 26-41, 44-50, 52-63 and 65-73 are pending in this application.

### **II. 35 U.S.C. § 101 Rejection**

Claims 66-69 stand rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter. The Office Action alleges that the claims are directed to non-statutory subject matter as they deal with “a system for redeeming promotions comprising a server and means for conducting the method steps” and a server and the means can be software. Office Action at 2-3. However, the Examiner offers no reasoning for interpreting these elements of claims 66-69 in a manner that renders the claims non-statutory.

As an initial matter, it is unclear why the Examiner contends that the recited server and/or means are software per se. Additionally, the claims do not themselves recite that the server and/or means are software, and particularly do not recite that these elements are merely software per se. Moreover, 35 U.S.C. § 112, sixth paragraph expressly permits claiming by means plus function elements. M.P.E.P. § 2181 sets out guidelines for Examiners to employ when examining such means plus function claims. As M.P.E.P. § 2181 expressly recognizes, the Court of Appeals for the Federal Circuit, in its *en banc* decision *In re Donaldson Co.*, 16 F.3d 1189, 29 USPQ2d 1845 (Fed. Cir. 1994), stated:

Per our holding, the “broadest reasonable interpretation” that an examiner may give means-plus-function language is that statutorily mandated in paragraph six. Accordingly, the PTO may not disregard the structure disclosed in the specification corresponding to such language when rendering a patentability determination.

Thus, the “USPTO must apply 35 U.S.C. § 112, sixth paragraph in appropriate cases, and give claims their broadest reasonable interpretation, in light of and consistent with the written description of the invention in the application.” M.P.E.P. § 2181(I). Here, the Examiner has apparently improperly chosen to ignore the corresponding structure of the recited “means” elements that is disclosed in the present application and has instead asserted that the recited “means” elements also *can be* software. Office Action at 3. The present application describes, however, that to the extent that the recited means elements may be implemented as software, such software may be stored in a tangible computer readable storage medium. Thus, when properly interpreted in light of and consistent with the written description in the application, there is no basis to interpret the recited means elements in a manner that renders the claims 66-69 non-statutory under 35 U.S.C. § 101. That is, to the extent that the means elements are interpreted as software, there is no reason to limit the interpretation of the means elements to mere software per se if that results in the claim being non-statutory, considering that support can be found in the specification for a statutory interpretation of the means elements, such as software stored to a tangible computer readable storage medium. The Examiner has not cited any limitations from the specification that mandate that these elements be merely software per se, and, as discussed above, the Examiner chooses to not further read into the elements corresponding structure disclosed in the specification that would appear to render the claims statutory even under the Examiner’s interpretation. As such, Applicant respectfully requests that this rejection be withdrawn.

### III. 35 U.S.C. § 103 Rejection

Claims 1-5, 7-14, 16-22, 26-41, 44-50, 52-63, 65 and 66-73 stand rejected under 35 U.S.C. § 103 as being unpatentable over *Narasimhan* in view of Official Notice. Applicant traverses these rejections and asserts that the claims are allowable, at least, for the reasons stated below.

Applicant notes that the rejections set forth in the Office Action with respect to *Narasimhan* seem to reference the December 7, 2007 Office Action. *See, e.g.*, Office Action at 5. However, the present Office Action fails to address Applicant's arguments made in response to the December 7, 2007 Office Action, the revised comments made by the Examiner in the April 22, 2008 or the interview summary mailed July 2, 2008. "Where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it." *See* M.P.E.P. § 707.07(f). Applicant therefore respectfully requests that the Examiner reconsider Applicant's previous arguments with respect to the *Narasimhan* reference, incorporated by reference as if set forth herein, in combination with the comments set forth below.

The Supreme Court stated that "[a] patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art." *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007). The Supreme Court also acknowledged the importance of identifying "a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does" in an obviousness determination. *Id.* at 1731. The Court indicated that there should be an "explicit" analysis regarding "whether there was an *apparent reason* to combine the known elements *in the fashion claimed* by the patent at issue." *Id.* (emphasis added). Further, the Court did not reject the use of the "teaching, suggestion, or motivation" test as a factor in the obviousness analysis, but rather stated that this test may be indicative of non-obviousness under 35 U.S.C. § 103. *Id.* When determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. M.P.E.P. § 2141.02(I).

### **1. Independent Claim 1 and Related Dependent Claims**

Independent claim 1 recites a method for distributing promotions comprising, in part, "wirelessly transmitting data relating to said promotion to a mobile electronic device of said specific consumer." Applicant maintains that the smart card of *Narasimhan* is not a mobile electronic device as set forth in claim 1 as it is not capable of wirelessly transmitting or receiving data through a network. The Office Action states that "[i]t appears Applicant

argues Narasimhan's portable card device . . . with its card reader to download coupons to the card is not a wireless device and wireless transmission of data to the wireless device and wirelessly applying the promotion using the mobile electronic device arguably is not disclosed in *Narasimhan*." Office Action at 6. The Office Action fails to challenge the statements in *Narasimhan* that the user of the smart card utilizes a smart card reader/writer to store coupons in a database on the smart card. *See, e.g.*, column 7, lines 23-27. As such, the coupons generated on a user's computer are transmitted for storage on the smart card only when the smart card is *physically* associated with the smart card reader/writer and *not* through any wireless mechanism.

The Office Action asserts that even if the above is conceded, several references allegedly provide support for the above reasoning or Official Noticed facts taken earlier by Examiner Myhre. Office Action at 6. Applicant is not aware of any Official Noticed facts taken earlier by Examiner Myhre and is not aware of a procedure by which the current examiner can rely on statements made by a previous examiner in a prior office action as official notice in the absence of any documentary evidence.

Further, the references cited by the Examiner to allegedly evidence the level of skill in the art at the time of the invention are insufficient to teach at least this limitation of claim 1. The Office Action states that "[i]t is known at the time of invention that the following types of user devices or terminals, wired or mobile or wireless, can all be used interchangeably to receive/transfer data including incentives or coupons data" and cites several patents as allegedly supporting this assertion. Office Action at 6-7. However, the cited patents fail to teach at least "wirelessly transmitting data relating to said promotion to a mobile electronic device of said specific consumer" as recited in claim 1. For example, *Kolls* discusses use of a smart card reader/writer but does not address how such a reader/writer may be interchanged with wireless devices and networks as the Office Action suggests. Rather, Figure 4 of *Kolls* is described as having mutually exclusive control means. *See, e.g.*, column 9, lines 37-38. It does not suggest that the various control means are interchangeable as the Office Action implies. In any event, there is no teaching in *Kolls* of a smart card and a smart card reader/writer being interchangeable with a wireless device nor is there any teaching of wirelessly transmitting data to such a combination or applying a promotion using such a combination. As such, *Kolls* does not evidence the level of skill in the art so as to allegedly



support the Office Action's reasoning related to *Narasimhan* or the alleged Official Noticed facts.

Moreover, *Freeman* merely references downloading onto a chip card through a cellular device having a chip card communications port. *See, e.g.*, column 8, lines 24-31. The chip card is then inserted into the POS terminal to establish communication. *See, e.g.*, column 16, lines 9-12; column 17, lines 5-7. Thus, communication, for example, to apply a promotion is by electrical connection of the chip card to the POS terminal. No description is provided to allege that communication is made through wireless means. In addition, *Freeman* does not evidence the state of the art allegedly teaching wirelessly transmitting data relating to a promotion to a mobile electronic device or wirelessly applying a promotion to a purchase using a mobile electronic device.

In addition, the Office Action's reliance on *Aggarwal* fails to demonstrate that various user devices or terminals may be used interchangeably with the smart card of *Narasimhan*. The portion of *Aggarwal* cited in the Office Action describes later downloading coupons in a portable device but does not equate a smart card of the type set forth in *Narasimhan* as being interchangeable with other wireless devices as set forth in Applicant's claims.

The Office Action has not demonstrated that the above-referenced patents evidence the level of skill in the art at the time of the invention so as to support the assertion that the allegedly Official Noticed facts discharge the burden of showing *prima facie* obviousness. As such, Applicant asserts that *Leapfrog v. Fisher-Price* is not applicable. The Office Action has failed to show that the references allegedly provide support for the reasoning set forth in the Office Action or the alleged Official Noticed facts taken earlier by Examiner Myhre. Moreover, the Office Action has not demonstrated how the smart card of *Narasimhan* could allegedly be updated with "modern components" or how the "modern components" allegedly teach what is claimed by Applicant. As the references cited in the Office Action do not demonstrate the interchangeability of the smart card device of *Narasimhan* with other user devices, Applicant asserts that it would not have been obvious to replace the "unit including the card interface of *Narasimhan* with a cell phone with chip card communications port as taught by *Freeman* or with a portable phone as taught in *Aggarwal* as the Office Action suggests. *See* Office Action at 9-10.

Further, while the Office Action alleges that it would have been obvious to incorporate the functionality of the smart card into other mobile devices (*see, e.g.*, Office Action at 7-10), Applicant respectfully disagrees. While the smart card may be carried around by the user, there is no teaching or suggestion set forth in the reference for incorporation of the smart card taught in *Narasimhan* into other mobile devices, and thus, the Examiner has not discharged the burden of showing *prima facie* obviousness. Thus, claim 1 should be deemed patentable over the rejection of record.

Moreover, the Examiner states that “it is a trend in the art for everybody to go mobile and do things on cellular phones/PDAs and the likes that used to be done in wired systems.” *See* Office Action at 7. From this statement, it appears that the Examiner is relying on impermissible hindsight in order to piece together the claim limitations. Thus, Applicant believes that the Examiner has either relied on his own personal knowledge, or taken Official Notice, with respect to this matter. Applicant is not aware of any reference contemporaneous with the filing of Applicant’s patent application that confirms such a trend. Alternatively, such an assertion without documentary evidence may be appropriate if the Office Action provides “specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge.” M.P.E.P. § 2144.03(B) (citing *In re Soli*, 317 F.2d at 946, 37 USPQ at 801, and *In re Chevenard*, 139 F.2d at 713, 60 USPQ at 241). However, because the above-quoted statement is merely an assertion, rather than reasoning, the Official Notice must fail. Under Rule 37 C.F.R. § 1.104(d)(2), the Examiner is hereby requested to provide and make of record an affidavit setting forth his data as specifically as possible for the assertion. Alternatively, under M.P.E.P. § 2144.03, the Examiner is hereby requested to cite a reference in support of the assertion. Otherwise the rejection of claim 1 should be withdrawn.

Further, independent claim 1 recites, in part, “wirelessly applying said promotion to a purchase using said mobile electronic device.” *Narasimhan* fails to teach or suggest this limitation. The Office Action alleges that the smart card is performing the functions of the claimed “mobile electronic device.” *See* Office Action at 10. The Office Action further suggests that “the promotion data (coupons) is being transmitted (and stored) onto the smart card and the merchant device is receiving a response from the smart card when querying the clipped coupon database to retrieve the promotion information (coupon).” *Id.* Again, the

smart card of *Narasimhan* is not a mobile electronic device as set forth in claim 1 as the smart card must be *physically connected* to the merchant device through a smart card reader/writer to allow the merchant device to read the coupons on the smart card. *See, e.g.*, column 7, lines 27-31. As such, a physical connection is required to apply a promotion to a purchase using the smart card of *Narasimhan* and a promotion is not being wirelessly applied using a mobile electronic device. The merchant does not read the clipped electronic coupons from a mobile electronic device in *Narasimhan* but rather reads the coupons stored on the database by use of a smart card reader/writer. The Office Action also alleges that “[o]ne would have been motivated to incorporate the functionality and storage of the smart card into other mobile devices, such a cell phone, in order to eliminate the need to carry multiple mobile devices (e.g. a smart card, a cell phone, AND a pager). *See* Office Action at 10-11. Again, while the smart card of *Narasimhan* may be carried around by the user, there is no teaching or suggestion set forth in the reference for incorporation of the smart card taught in *Narasimhan* into other mobile devices as discussed above, and thus, the Examiner has not discharged the burden of showing *prima facie* obviousness. Thus, *Narasimhan* does not teach or suggest this limitation of claim 1.

Claims 2-5 and 7-12 depend directly or indirectly from base claim 1 and thus inherit all limitations of base claim 1. However, each of these claims set forth features and limitations not recited by the references. For example, claim 3 recites “receiving a response from said mobile electronic device of said specific consumer, wherein said response is received wirelessly.” *Narasimhan* does not teach or suggest this limitation as the smart card does not provide a response. Even assuming *arguendo* that the smart card provides a response, it does not do so without being swiped through or inserted into a card reader connected to the merchant device which reads clipped electronic coupons stored on the smart card. *See, e.g.*, column 7, lines 27-31. Thus, any response received from the smart card of *Narasimhan* is not received wirelessly. Similarly, claims 7 and 8 are not taught or suggested by *Narasimhan* as text messages or voice mail messages are not transmitted from a smart card. These messages are now known to be wirelessly transmitted, and data is not pulled from the smart card of *Narasimhan* other than by swiping or inserting the smart card through a card reader. Moreover, the electronic coupon itself is read from the smart card, and thus, no data is transmitted from the smart card in the form of a text message or voice mail message.

Thus, Applicant respectfully asserts that for the above reasons, claims 2-5 and 7-12 are patentable over the rejections of record.

## **2. Independent Claim 13 and Related Dependent Claims**

Independent claim 13 recites, in part, “a method of wirelessly receiving and redeeming promotions via a mobile electronic device.” *Narasimhan* does not teach or suggest this limitation. A user of the smart card disclosed in *Narasimhan* does not wirelessly receive or redeem promotions via the smart card. Rather, the user clips the coupon while sitting at his/her personal computer and stores the coupon in a database on the smart card by employing a smart card reader/writer. *See, e.g.*, column 7, lines 23-27. Further, the user redeems a coupon stored on the smart card by swiping or inserting the smart card through a smart card reader/writer attached to the merchant device. *See, e.g.*, column 6, lines 52-55; column 7, lines 27-31. The smart card therefore is tethered to the reader/writer in order for promotions to be read from or stored onto the smart card. The Office Action alleges that “the smart card replies to an inquiry from the merchant device by retrieving (accessing) the promotion (coupon) data from the database when redeeming the promotion and transmitting (replying) the data to the merchant device. *See* Office Action at 14. Applicant respectfully disagrees that this assertion indicates that the limitations of claim 13 have been met. Rather, as previously discussed, the user clips the coupon while sitting at his/her personal computer and stores the coupon in a database on the smart card by employing a smart card reader/writer. *See, e.g.*, column 7, lines 23-27. The smart card reader/writer later retrieves the coupon from the smart card, and thus, the smart card does not behave as a mobile electronic device to receive and redeem promotions in accordance with claim 13. Thus, independent claim 13 should be deemed patentable over the rejection of record.

Further, claim 13 recites, in part, “accessing, with said mobile electronic device, data, relating to said promotion, wirelessly transmitted to said mobile electronic device from a server.” *Narasimhan* fails to teach or suggest this limitation. Again, no data relating to a promotion is wirelessly transmitted to the smart card from a server. Rather, the user clips the coupon while sitting at his/her personal computer and stores the coupon in a database on the smart card by inserting or swiping the smart card into a smart card reader/writer. *See, e.g.*,

column 7, lines 23-27. Accordingly, the user's personal computer receives the data from the server, not the smart card. As such, claim 13 is patentable over the rejection of record.

Independent claim 13 also recites, in part, "redeeming said promotion by wirelessly replying to said server using said mobile electronic device." *Narasimhan* fails to teach or suggest this limitation. The smart card of *Narasimhan* does not include any mechanism (i.e., input means or the like) to allow a user of a smart card to wirelessly reply to a server using the smart card. Rather, the smart card is swiped or inserted into a smart card reader/writer so as to permit a promotion to be redeemed, and it is the merchant device or the user's personal computer, depending on the stage when the promotion is to be redeemed, and not the smart card, that communicates with the server to redeem a promotion. *See, e.g.*, column 6, lines 52-57; column 7, lines 27-31. Moreover, the Office Action (*see* Office Action at 14) fails to demonstrate how *Narasimhan* and *Aggarwal* allegedly may be combined so as to set forth a *prima facie* case of obviousness. Thus, claim 13 is patentable over the rejection of record.

Claims 14 and 16-21 depend directly or indirectly from base claim 13 and thus inherit all limitations of base claim 13. However, each of these claims set forth features and limitations not recited by these references. For example, claim 16 recites that "said consumer wirelessly requests said promotion from said server by using said mobile electronic device." *Narasimhan* fails to teach or suggest this limitation again because the smart card does not include any mechanism (i.e., input means or the like) to allow a user of a smart card to wirelessly request a promotion from a server. Rather, any communication that the user of the smart card has with a server occurs via action by the merchant device or the user's personal computer, not the smart card. *See, e.g.*, column 6, lines 30-36 and 52-57; column 7, lines 27-31. The Office Action alleges that *Narasimhan* teaches this limitation as it allegedly "discloses a promotion distributor generating the promotion based on a request from the consumer." Office Action at 20. However, the cited passages from *Narasimhan* merely teach that the user browses promotions on his/her personal computer (column 3, lines 10-16) and does not teach that a consumer wirelessly requests a promotion from the server by using a mobile electronic device.

Further, claim 21 recites "wherein said redeeming is by telephone, text message, or multi-media message." *Narasimhan* fails to teach or suggest this limitation. While the

Examiner is correct that promotional information set forth in *Narasimhan* may be textual, graphic, video or audio information (*see* Office Action at 19 referencing column 3, lines 28-35 of *Narasimhan*), nowhere does *Narasimhan* teach or suggest that a promotion may be redeemed by telephone, text message or multi-media message. Text messages or voice mail messages are not transmitted from a smart card. These messages are now known to be wirelessly transmitted, and data is not pulled from the smart card of *Narasimhan* other than by swiping or inserting the smart card through a card reader. Moreover, the electronic coupon itself is read from the smart card, and thus, no data is transmitted from the smart card in the form of a text message or voice mail message. Thus, Applicant respectfully asserts that for the above reasons, claims 14 and 16-21 are patentable over the rejection of record.

### 3. Independent Claim 22

Independent claim 22 recites a method for distributing a promotion comprising, in part, “sending promotion data to a consumer web portal account wirelessly accessible on a mobile electronic device of said consumer.” *Narasimhan* fails to teach or suggest this limitation. Promotion data is not wirelessly accessible on the smart card of *Narasimhan*. Rather, the smart card must be physically associated with a smart card reader/writer in order for promotion data to be stored on or retrieved from the smart card. *See, e.g.*, column 7, lines 23-27. Moreover, *Narasimhan* does not teach or suggest that a consumer web portal account is wirelessly accessible on a smart card. Even assuming *arguendo* that a consumer web portal account is disclosed in *Narasimhan*, it is the user’s personal computer that accesses a server containing a web portal account, not the smart card. *See, e.g.*, column 4, lines 9-20. Thus, claim 22 should be deemed patentable over the rejection of record.

Further, independent claim 22 recites, in part, “saving said promotion in a promotion saving account accessible by said mobile electronic device wherein said consumer wirelessly redeems said promotion using said mobile electronic device for a purchase at a point of sale (POS).” *Narasimhan* fails to teach or suggest this limitation. Again, the smart card of *Narasimhan* does not meet the limitations of a mobile electronic device as set forth in claim 22 as the smart card must be physically connected to the merchant device through a smart card reader/writer to allow the merchant device to read the coupons on the smart card. *See, e.g.*, column 7, lines 27-31. A user of the smart card disclosed in *Narasimhan* swipes or

swipes or inserts the smart card through a smart card reader/writer connected to the merchant device so that the merchant device may access the coupons stored on the smart card. The merchant device then redeems the promotion. *See, e.g.*, column 7, lines 27-31. The Office Action appears to assert that a database in *Narasimhan* “would inherently be accessible by the smart card when redeeming the coupon at the merchant device.” *See* Office Action at 15. However, this inherency argument provides no justification for the assertion that this claim limitation is allegedly taught by *Narasimhan*, as the Examiner is required to provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. M.P.E.P. § 2112. Moreover, the Office Action appears to rely on a combination of *Narasimhan* and *Aggarwal* to allege that this limitation has been met (*see* Office Action at 15); however, the Office Action does not indicate how these references may be combined and does not show an apparent reason to combine the elements in the fashion claimed in claim 22. As such, the Examiner has not discharged his burden of making a *prima facie* case of obviousness with respect to claim 22.

#### 4. Independent Claim 26 and Related Dependent Claims

Independent claim 26 recites, in part, “a method for wirelessly distributing a promotion to a mobile electronic device of a targeted consumer.” *Narasimhan* does not teach or suggest this limitation. A promotion is not wirelessly distributed to the smart card disclosed in *Narasimhan*. Rather, the user accesses the promotion via his/her personal computer, and the promotion is stored on the smart card by *physically* associating the smart card with a smart card reader/writer attached to the personal computer. *See, e.g.*, column 7, lines 23-27. Thus, the promotion is not being wirelessly distributed to the smart card. As such, this limitation of claim 26 has not been met.

Claim 26 further recites “wirelessly transmitting data relating to said promotion to said mobile electronic device of said targeted consumer.” *Narasimhan* does not teach or suggest this limitation. Applicant maintains that the smart card of *Narasimhan* is not a mobile electronic device as set forth in claim 26 as it is not capable of wirelessly transmitting or receiving data through a network. The Office Action states that “[i]t appears Applicant argues *Narasimhan*’s portable card device . . . with its card reader to download coupons to the

card is not a wireless device and wireless transmission of data to the wireless device and wirelessly applying the promotion using the mobile electronic device arguably is not disclosed in *Narasimhan*.” Office Action at 6. The Office Action fails to challenge the statements in *Narasimhan* that the user of the smart card utilizes a smart card reader/writer to store coupons in a database on the smart card. *See, e.g.*, column 7, lines 23-27. As such, the coupons generated on a user’s computer are transmitted for storage on the smart card only when the smart card is *physically* associated with the smart card reader/writer and *not* through any wireless mechanism.

The Office Action asserts that even if the above is conceded, several references allegedly provide support for the above reasoning or Official Noticed facts taken earlier by Examiner Myhre. Office Action at 6. Applicant is not aware of any Official Noticed facts taken earlier by Examiner Myhre and is not aware of a procedure by which the current examiner can rely on statements made by a previous examiner in a prior office action as official notice in the absence of any documentary evidence.

In any event, the references cited by the Examiner to allegedly evidence the level of skill in the art at the time of the invention are insufficient to teach at least this limitation of claim 26. The Office Action states that “[i]t is known at the time of invention that the following types of user devices or terminals, wired or mobile or wireless, can all be used interchangeably to receive/transfer data including incentives or coupons data” and cites several patents as allegedly supporting this assertion. Office Action at 6-7. However, the cited patents fail to teach at least “wirelessly transmitting data relating to said promotion to a mobile electronic device of said targeted consumer” as recited in claim 26. For example, *Kolls* discusses use of a smart card reader/writer but does not address how such a reader/writer may be interchanged with wireless devices and networks as the Office Action suggests. Rather, Figure 4 of *Kolls* is described as having mutually exclusive control means. *See, e.g.*, column 9, lines 37-38. It does not suggest that the various control means are interchangeable as the Office Action implies. In any event, there is no teaching in *Kolls* of a smart card and a smart card reader/writer being interchangeable with a wireless device nor is there any teaching of wirelessly transmitting data to such a combination or applying a promotion using such a combination. As such, *Kolls* does not evidence the level of skill in



the art so as to allegedly support the Office Action's reasoning related to *Narasimhan* or the alleged Official Noticed facts.

Moreover, *Freeman* merely references downloading onto a chip card through a cellular device having a chip card communications port. *See, e.g.*, column 8, lines 24-31. The chip card is then inserted into the POS terminal to establish communication. *See, e.g.*, column 16, lines 9-12; column 17, lines 5-7. Thus, communication, for example, to apply a promotion is by electrical connection of the chip card to the POS terminal. No description is provided to allege that communication is made through wireless means. In addition, *Freeman* does not evidence the state of the art allegedly teaching wirelessly transmitting data relating to a promotion to a mobile electronic device or wirelessly applying a promotion to a purchase using a mobile electronic device.

In addition, the Office Action's reliance on *Aggarwal* fails to demonstrate that various user devices or terminals may be used interchangeably with the smart card of *Narasimhan*. The portion of *Aggarwal* cited in the Office Action describes later downloading coupons in a portable device but does not equate a smart card of the type set forth in *Narasimhan* as being interchangeable with other wireless devices as set forth in Applicant's claims.

The Office Action has not demonstrated that the above-referenced patents evidence the level of skill in the art at the time of the invention so as to support the assertion that the allegedly Official Noticed facts discharge the burden of showing *prima facie* obviousness. As such, Applicant asserts that *Leapfrog v. Fisher-Price* is not applicable. The Office Action has failed to show that the references allegedly provide support for the reasoning set forth in the Office Action or the alleged Official Noticed facts taken earlier by Examiner Myhre. Moreover, the Office Action has not demonstrated how the smart card of *Narasimhan* could allegedly be updated with "modern components" or how the "modern components" allegedly teach what is claimed by Applicant. As the references cited in the Office Action do not demonstrate the interchangeability of the smart card device of *Narasimhan* with other user devices, Applicant asserts that it would not have been obvious to replace the "unit including the card interface of *Narasimhan* with a cell phone with chip card communications port as taught by *Freeman* or with a portable phone as taught in *Aggarwal* as the Office Action suggests. *See* Office Action at 9-10.

Further, while the Office Action alleges that it would have been obvious to incorporate the functionality of the smart card into other mobile devices (*see, e.g.*, Office Action at 7-10), Applicant respectfully disagrees. While the smart card may be carried around by the user, there is no teaching or suggestion set forth in the reference for incorporation of the smart card taught in *Narasimhan* into other mobile devices, and thus, the Examiner has not discharged the burden of showing *prima facie* obviousness. Thus, claim 26 should be deemed patentable over the rejection of record.

Moreover, the Examiner states that “it is a trend in the art for everybody to go mobile and do things on cellular phones/PDAs and the likes that used to be done in wired systems.” *See* Office Action at 7. From this statement, it appears that the Examiner is relying on impermissible hindsight in order to piece together the claim limitations. Thus, Applicant believes that the Examiner has either relied on his own personal knowledge, or taken Official Notice, with respect to this matter. Applicant is not aware of any reference contemporaneous with the filing of Applicant’s patent application that confirms such a trend. Alternatively, such an assertion without documentary evidence may be appropriate if the Office Action provides “specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge.” M.P.E.P. § 2144.03(B) (citing *In re Soli*, 317 F.2d at 946, 37 USPQ at 801, and *In re Chevenard*, 139 F.2d at 713, 60 USPQ at 241). However, because the above-quoted statement is merely an assertion, rather than reasoning, the Official Notice must fail. Under Rule 37 C.F.R. § 1.104(d)(2), the Examiner is hereby requested to provide and make of record an affidavit setting forth his data as specifically as possible for the assertion. Alternatively, under M.P.E.P. § 2144.03, the Examiner is hereby requested to cite a reference in support of the assertion. Otherwise the rejection of claim 26 should be withdrawn.

Further, data relating to a promotion is not wirelessly transmitted to the smart card disclosed in *Narasimhan*. Rather, the user accesses the promotion via his/her personal computer, and the promotion is stored on the smart card by physically associating the smart card with a smart card reader/writer attached to the personal computer. *See, e.g.*, column 7, lines 23-27. Thus, a physical connection is needed between the smart card reader/writer and the smart card, and even so, the data is transmitted to the user’s personal computer, not to the smart card. As such, claim 26 should be deemed patentable over the rejection of record.

The Office Action also states that Applicant has argued that the step of “generating said promotion for use by a targeted consumer, wherein said targeted consumer is selected from a plurality of potential consumers” is not disclosed. *See* Office Action at 11. Applicant respectfully disagrees as Applicant did not previously present this argument with respect to *Narasimhan*. Rather, in the Amendment Accompanying Request for Continued Examination filed July 22, 2008, Applicant merely stated that the additional art referenced by the Examiner does not teach at least this step. *See* Amendment at 14. Regardless, the Office Action has not shown that this step of claim 26 is taught by *Narasimhan*. Instead, the Office Action merely states that *Narasimhan* allegedly “discloses transmitting data relating to the promotion to a mobile electronic device.” However, *Narasimhan* does not transmit data relating to a promotion to a mobile electronic device as Applicant asserts that the smart card of *Narasimhan* is not a mobile electronic device. Further, as discussed above, claim 26 is directed to a method for wirelessly distributing a promotion to a mobile electronic device of a targeted consumer. Given that *Narasimhan* does not teach wirelessly distributing a promotion to a mobile electronic device of a targeted consumer or wirelessly transmitting data relating to said promotion to said mobile electronic device of said targeted consumer, it follows that *Narasimhan* cannot teach generating the promotion for use by such a targeted consumer.

Claims 27-29 depend directly or indirectly from base claim 26 and thus inherit all limitations of base claim 26. However, each of these claims set forth features and limitations not recited by these references. Thus, Applicant respectfully asserts that for the above reasons, claims 27-29 are patentable over the rejection of record.

## **5. Independent Claim 30 and Related Dependent Claims**

Independent claim 30 recites, in part, “a method of wirelessly distributing a promotion to a mobile electronic device of a requesting consumer.” *Narasimhan* does not teach or suggest this limitation. A promotion is not wirelessly distributed to the smart card disclosed in *Narasimhan*. Rather, the user accesses the promotion via his/her personal computer, and the promotion is stored on the smart card by physically associating the smart card with a smart card reader/writer attached to the personal computer. *See, e.g.*, column 7, lines 23-27.

Thus, the promotion is not being wirelessly distributed to the smart card. As such, this limitation of claim 30 has not been met.

Claim 30 further recites “wirelessly transmitting data relating to said promotion to said mobile electronic device of said requesting consumer.” *Narasimhan* does not teach or suggest this limitation. Applicant maintains that the smart card of *Narasimhan* is not a mobile electronic device as set forth in claim 30 as it is not capable of wirelessly transmitting or receiving data through a network. The Office Action states that “[i]t appears Applicant argues Narasimhan’s portable card device . . . with its card reader to download coupons to the card is not a wireless device and wireless transmission of data to the wireless device and wirelessly applying the promotion using the mobile electronic device arguably is not disclosed in *Narasimhan*.” Office Action at 6. The Office Action fails to challenge the statements in *Narasimhan* that the user of the smart card utilizes a smart card reader/writer to store coupons in a database on the smart card. *See, e.g.*, column 7, lines 23-27. As such, the coupons generated on a user’s computer are transmitted for storage on the smart card only when the smart card is *physically* associated with the smart card reader/writer and *not* through any wireless mechanism.

The Office Action asserts that even if the above is conceded, several references allegedly provide support for the above reasoning or Official Noticed facts taken earlier by Examiner Myhre and Applicant is not aware of a procedure by which the current examiner can rely on statements made by a previous examiner in a prior office action as official notice in the absence of any documentary evidence. Office Action at 6. Applicant is not aware of any Official Noticed facts taken earlier by Examiner Myhre.

Further, the references cited by the Examiner to allegedly evidence the level of skill in the art at the time of the invention are insufficient to teach at least this limitation of claim 30. The Office Action states that “[i]t is known at the time of invention that the following types of user devices or terminals, wired or mobile or wireless, can all be used interchangeably to receive/transfer data including incentives or coupons data” and cites several patents as allegedly supporting this assertion. Office Action at 6-7. However, the cited patents fail to teach at least “wirelessly transmitting data relating to said promotion to a mobile electronic device of said specific consumer” as recited in claim 30. For example, *Kolls* discusses use of

a smart card reader/writer but does not address how such a reader/writer may be interchanged with wireless devices and networks as the Office Action suggests. Rather, Figure 4 of *Kolls* is described as having mutually exclusive control means. *See, e.g.*, column 9, lines 37-38. It does not suggest that the various control means are interchangeable as the Office Action implies. In any event, there is no teaching in *Kolls* of a smart card and a smart card reader/writer being interchangeable with a wireless device nor is there any teaching of wirelessly transmitting data to such a combination or applying a promotion using such a combination. As such, *Kolls* does not evidence the level of skill in the art so as to allegedly support the Office Action's reasoning related to *Narasimhan* or the alleged Official Noticed facts.

Moreover, *Freeman* merely references downloading onto a chip card through a cellular device having a chip card communications port. *See, e.g.*, column 8, lines 24-31. The chip card is then inserted into the POS terminal to establish communication. *See, e.g.*, column 16, lines 9-12; column 17, lines 5-7. Thus, communication, for example, to apply a promotion is by electrical connection of the chip card to the POS terminal. No description is provided to allege that communication is made through wireless means. In addition, *Freeman* does not evidence the state of the art allegedly teaching wirelessly transmitting data relating to a promotion to a mobile electronic device.

In addition, the Office Action's reliance on *Aggarwal* fails to demonstrate that various user devices or terminals may be used interchangeably with the smart card of *Narasimhan*. The portion of *Aggarwal* cited in the Office Action describes later downloading coupons in a portable device but does not equate a smart card of the type set forth in *Narasimhan* as being interchangeable with other wireless devices as set forth in Applicant's claims.

The Office Action has not demonstrated that the above-referenced patents evidence the level of skill in the art at the time of the invention so as to support the assertion that the allegedly Official Noticed facts discharge the burden of showing *prima facie* obviousness. As such, Applicant asserts that *Leapfrog v. Fisher-Price* is not applicable. The Office Action has failed to show that the references allegedly provide support for the reasoning set forth in the Office Action or the alleged Official Noticed facts taken earlier by Examiner Myhre. Moreover, the Office Action has not demonstrated how the smart card of *Narasimhan* could

allegedly be updated with “modern components” or how the “modern components” allegedly teach what is claimed by Applicant. As the references cited in the Office Action do not demonstrate the interchangeability of the smart card device of *Narasimhan* with other user devices, Applicant asserts that it would not have been obvious to replace the “unit including the card interface of *Narasimhan* with a cell phone with chip card communications port as taught by Freeman or with a portable phone as taught in Aggarwal as the Office Action suggests. *See* Office Action at 9-10.

Further, while the Office Action alleges that it would have been obvious to incorporate the functionality of the smart card into other mobile devices (*see, e.g.*, Office Action at 7-10), Applicant respectfully disagrees. While the smart card may be carried around by the user, there is no teaching or suggestion set forth in the reference for incorporation of the smart card taught in *Narasimhan* into other mobile devices, and thus, the Examiner has not discharged the burden of showing *prima facie* obviousness. Thus, claim 30 should be deemed patentable over the rejection of record.

Moreover, the Examiner states that “it is a trend in the art for everybody to go mobile and do things on cellular phones/PDAs and the likes that used to be done in wired systems.” *See* Office Action at 7. From this statement, it appears that the Examiner is relying on impermissible hindsight in order to piece together the claim limitations. Thus, Applicant believes that the Examiner has either relied on his own personal knowledge, or taken Official Notice, with respect to this matter. Applicant is not aware of any reference contemporaneous with the filing of Applicant’s patent application that confirms such a trend. Alternatively, such an assertion without documentary evidence may be appropriate if the Office Action provides “specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge.” M.P.E.P. § 2144.03(B) (citing *In re Soli*, 317 F.2d at 946, 37 USPQ at 801, and *In re Chevenard*, 139 F.2d at 713, 60 USPQ at 241). However, because the above-quoted statement is merely an assertion, rather than reasoning, the Official Notice must fail. Under Rule 37 C.F.R. § 1.104(d)(2), the Examiner is hereby requested to provide and make of record an affidavit setting forth his data as specifically as possible for the assertion. Alternatively, under M.P.E.P. § 2144.03, the Examiner is hereby requested to cite a reference in support of the assertion. Otherwise the rejection of claim 30 should be withdrawn.

Further, data relating to a promotion is not wirelessly transmitted to the smart card disclosed in *Narasimhan*. Rather, the user accesses the promotion via his/her personal computer, and the promotion is stored on the smart card by physically associating the smart card with a smart card reader/writer attached to the personal computer. *See, e.g.*, column 7, lines 23-27. Thus, a physical connection is needed between the smart card reader/writer and the smart card, and even so, the data is transmitted to the user's personal computer, not to the smart card. As such, claim 30 should be deemed patentable over the rejection of record.

The Office Action also states that Applicant has previously argued that the step of "generating said promotion for use by a requesting consumer, wherein said requesting consumer is promoted to request said promotion" is not disclosed. *See* Office Action at 11. Applicant respectfully disagrees as Applicant did not previously present this argument with respect to *Narasimhan*. Rather, in the Amendment Accompanying Request for Continued Examination filed July 22, 2008, Applicant merely stated that the additional art referenced by the Examiner does not teach at least this step. *See* Amendment at 14. Regardless, the Office Action has not shown that this step of claim 30 is taught by *Narasimhan*. Instead, the Office Action merely states that *Narasimhan* allegedly "discloses transmitting data relating to the promotion to a mobile electronic device." However, *Narasimhan* does not transmit data relating to a promotion to a mobile electronic device as Applicant asserts that the smart card of *Narasimhan* is not a mobile electronic device. Further, as discussed above, claim 30 is directed to a method for wirelessly distributing a promotion to a mobile electronic device of a requesting consumer. Given that *Narasimhan* does not teach wirelessly distributing a promotion to a mobile electronic device of a requesting consumer or wirelessly transmitting data relating to said promotion to said mobile electronic device of said requesting consumer, it follows that *Narasimhan* does not teach generating the promotion for use by the requesting consumer.

Claims 31-36 depend directly or indirectly from base claim 30 and thus inherit all limitations of base claim 30. However, each of these claims set forth features and limitations not recited by these references. For example, claim 35 recites that the requesting consumer contacts the distributor via his/her mobile electronic device by calling a telephone number, sending an email message, or sending a text message. A user cannot use the smart card of *Narasimhan* to contact the distributor by calling a phone number, sending an email message

or sending a text message, and there are no input means on the smart card making it feasible to do so. Similarly, claim 33 recites that “said requesting consumer contacts a distributor to request said promotion using said mobile electronic device.” *Narasimhan* does not teach or suggest this limitation as the user of a smart card does not contact a distributor to request a promotion using the smart card. Rather, the user communicates with the distributor, using, for example, his/her personal computer. When the promotion is later received, it is only then saved onto the smart card, and there are no input means on the smart card making it feasible to do so. *See, e.g.*, column 6, lines 30-36; column 7, lines 23-27. The Office Action alleges that *Narasimhan* teaches this limitation as it allegedly “discloses a promotion distributor generating the promotion based on a request from the consumer.” Office Action at 20. However, the cited passages from *Narasimhan* merely teach that the user browses promotions on his/her personal computer (column 3, lines 10-16) and does not teach that a consumer wirelessly requests a promotion from the server by using a mobile electronic device. Thus, Applicant respectfully asserts that for the above reasons, claims 31-36 are patentable over the rejection of record.

## 6. Independent Claim 37 and Related Dependent Claims

Independent claim 37 recites a method for distributing a promotional offer to a targeted consumer comprising, in part, “wirelessly transmitting said offer to a mobile electronic device of said targeted consumer, wherein said targeted consumer is selected from a plurality of potential consumers.” *Narasimhan* fails to teach or suggest this limitation. Specifically, an offer is not wirelessly transmitted to the smart card disclosed in *Narasimhan*. Rather, the offer is transmitted to the user’s personal computer. Only when the electronic coupon associated with the offer is later received by the personal computer is the electronic coupon then saved onto the smart card. *See, e.g.*, column 6, lines 30-36; column 7, lines 23-27. Thus, this limitation of claim 37 has not been met.

Applicant also maintains that the smart card of *Narasimhan* is not a mobile electronic device as set forth in claim 37 as it is not capable of wirelessly transmitting or receiving data through a network. The Office Action states that “[i]t appears Applicant argues *Narasimhan*’s portable card device . . . with its card reader to download coupons to the card is not a wireless device and wireless transmission of data to the wireless device and wirelessly



applying the promotion using the mobile electronic device arguably is not disclosed in *Narasimhan*.” Office Action at 6. The Office Action fails to challenge the statements in *Narasimhan* that the user of the smart card utilizes a smart card reader/writer to store coupons in a database on the smart card. *See, e.g.*, column 7, lines 23-27. As such, the coupons generated on a user’s computer are transmitted for storage on the smart card only when the smart card is *physically* associated with the smart card reader/writer and *not* through any wireless mechanism.

The Office Action asserts that even if the above is conceded, several references allegedly provide support for the above reasoning or Official Noticed facts taken earlier by Examiner Myhre, and Applicant is not aware of a procedure by which the current examiner can rely on statements made by a previous examiner in a prior office action as official notice in the absence of any documentary evidence. Office Action at 6. Applicant is not aware of any Official Noticed facts taken earlier by Examiner Myhre.

Further, the references cited by the Examiner to allegedly evidence the level of skill in the art at the time of the invention are insufficient to teach at least this limitation of claim 37. The Office Action states that “[i]t is known at the time of invention that the following types of user devices or terminals, wired or mobile or wireless, can all be used interchangeably to receive/transfer data including incentives or coupons data” and cites several patents as allegedly supporting this assertion. Office Action at 6-7. However, the cited patents fail to teach at least “wirelessly transmitting said offer to a mobile electronic device of said targeted consumer” as recited in claim 37. For example, *Kolls* discusses use of a smart card reader/writer but does not address how such a reader/writer may be interchanged with wireless devices and networks as the Office Action suggests. Rather, Figure 4 of *Kolls* is described as having mutually exclusive control means. *See, e.g.*, column 9, lines 37-38. It does not suggest that the various control means are interchangeable as the Office Action implies. In any event, there is no teaching in *Kolls* of a smart card and a smart card reader/writer being interchangeable with a wireless device nor is there any teaching of wirelessly transmitting data to such a combination or applying a promotion using such a combination. As such, *Kolls* does not evidence the level of skill in the art so as to allegedly support the Office Action’s reasoning related to *Narasimhan* or the alleged Official Noticed facts.

Moreover, *Freeman* merely references downloading onto a chip card through a cellular device having a chip card communications port. *See, e.g.*, column 8, lines 24-31. The chip card is then inserted into the POS terminal to establish communication. *See, e.g.*, column 16, lines 9-12; column 17, lines 5-7. Thus, communication, for example, to apply a promotion is by electrical connection of the chip card to the POS terminal. No description is provided to allege that communication is made through wireless means. In addition, *Freeman* does not evidence the state of the art allegedly teaching wirelessly transmitting data relating to a promotion to a mobile electronic device or wirelessly applying a promotion to a purchase using a mobile electronic device.

In addition, the Office Action's reliance on *Aggarwal* fails to demonstrate that various user devices or terminals may be used interchangeably with the smart card of *Narasimhan*. The portion of *Aggarwal* cited in the Office Action describes later downloading coupons in a portable device but does not equate a smart card of the type set forth in *Narasimhan* as being interchangeable with other wireless devices as set forth in Applicant's claims.

The Office Action has not demonstrated that the above-referenced patents evidence the level of skill in the art at the time of the invention so as to support the assertion that the allegedly Official Noticed facts discharge the burden of showing *prima facie* obviousness. As such, Applicant asserts that *Leapfrog v. Fisher-Price* is not applicable. The Office Action has failed to show that the references allegedly provide support for the reasoning set forth in the Office Action or the alleged Official Noticed facts taken earlier by Examiner Myhre. Moreover, the Office Action has not demonstrated how the smart card of *Narasimhan* could allegedly be updated with "modern components" or how the "modern components" allegedly teach what is claimed by Applicant. As the references cited in the Office Action do not demonstrate the interchangeability of the smart card device of *Narasimhan* with other user devices, Applicant asserts that it would not have been obvious to replace the "unit including the card interface of *Narasimhan* with a cell phone with chip card communications port as taught by *Freeman* or with a portable phone as taught in *Aggarwal* as the Office Action suggests. *See* Office Action at 9-10.

Further, while the Office Action alleges that it would have been obvious to incorporate the functionality of the smart card into other mobile devices (*see, e.g.*, Office

Action at 7-10), Applicant respectfully disagrees. While the smart card may be carried around by the user, there is no teaching or suggestion set forth in the reference for incorporation of the smart card taught in *Narasimhan* into other mobile devices, and thus, the Examiner has not discharged the burden of showing *prima facie* obviousness. Thus, claim 37 should be deemed patentable over the rejection of record.

Moreover, the Examiner states that “it is a trend in the art for everybody to go mobile and do things on cellular phones/PDAs and the likes that used to be done in wired systems.” *See* Office Action at 7. From this statement, it appears that the Examiner is relying on impermissible hindsight in order to piece together the claim limitations. Thus, Applicant believes that the Examiner has either relied on his own personal knowledge, or taken Official Notice, with respect to this matter. Applicant is not aware of any reference contemporaneous with the filing of Applicant’s patent application that confirms such a trend. Alternatively, such an assertion without documentary evidence may be appropriate if the Office Action provides “specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge.” M.P.E.P. § 2144.03(B) (citing *In re Soli*, 317 F.2d at 946, 37 USPQ at 801, and *In re Chevenard*, 139 F.2d at 713, 60 USPQ at 241). However, because the above-quoted statement is merely an assertion, rather than reasoning, the Official Notice must fail. Under Rule 37 C.F.R. § 1.104(d)(2), the Examiner is hereby requested to provide and make of record an affidavit setting forth his data as specifically as possible for the assertion. Alternatively, under M.P.E.P. § 2144.03, the Examiner is hereby requested to cite a reference in support of the assertion. Otherwise the rejection of claim 37 should be withdrawn.

Independent claim 37 further recites “receiving a reply from said mobile electronic device of said targeted consumer in response to said promotional offer.” *Narasimhan* also fails to teach or suggest this limitation. The smart card of *Narasimhan* does not reply to a promotional offer. Rather, the user considers the promotional offer by reviewing the offer on his/her personal computer. If the offer is later accepted, the user will receive an electronic coupon that is then saved onto the smart card. *See, e.g.*, column 6, lines 30-36; column 7, lines 23-27. Accordingly, the user of the system set forth in *Narasimhan* makes a decision as to whether to reply to a promotional offer using his/her personal computer and not the smart card. Further, there are no input means provided on the smart card to permit a user to reply to

an offer using said smart card. Accordingly, Applicant respectfully asserts that claim 37 is patentable over the rejection of record.

The Office Action further suggests that Applicant has previously argued that “facilitating a purchase by said targeted consumer, said purchase correlated to said promotional offer” is not disclosed by *Narasimhan*. See Office Action at 11. Applicant respectfully disagrees as Applicant has previously presented this argument with respect to *Narasimhan*. Rather, in the Amendment Accompanying Request for Continued Examination filed July 22, 2008, Applicant merely stated that the additional art referenced by the Examiner does not teach at least this step. See Amendment at 14. Regardless, the Examiner has not discharged the burden of showing *prima facie* obviousness with respect to the combination of applied references.

Claims 38-40 depend directly or indirectly from base claim 37 and thus inherit all limitations of base claim 37. However, each of these claims set forth features and limitations not recited by these references. Thus, Applicant respectfully asserts that for the above reasons, claims 38-40 are patentable over the rejection of record.

#### **7. Independent Claim 41 and Related Dependent Claims**

Independent claim 41 recites a system for distributing and redeeming a promotion comprising, in part, “a mobile electronic device operable for wirelessly transmitting a request for promotional data and for wirelessly receiving generated promotion data.” *Narasimhan* fails to teach or suggest this limitation. As previously discussed, the smart card of *Narasimhan* does not wirelessly transmit a request for promotional data or wirelessly receive generated promotion data. Rather, the user requests and reviews promotions presented on his/her personal computer (*see, e.g.*, column 3, lines 9-16). When the user wishes to take advantage of a promotion, he/she requests a coupon associated with the promotion (*see, e.g.*, column 6, lines 30-36) which may then be saved to the smart card which is physically associated with the personal computer via a smart card reader/writer (*see, e.g.*, column 7, lines 23-27). Accordingly, the smart card of *Narasimhan* neither wirelessly transmits a request for promotional data nor does it wirelessly receive generated promotional data.

The Office Action further alleges that the smart card “has at least one input means and at least output means (in order to receive and send the promotional data to and from the database” and thus “it is inherently capable of transmitting the request through its output means and receiving the promotional data through its input means.” *See* Office Action at 16. Applicant respectfully disagrees. The Office Action fails to identify the alleged input and output means of the smart card of *Narasimhan*. Rather, data is placed onto the smart card via a smart card reader/writer as discussed above. *See, e.g.*, column 7, lines 23-27. In order to properly establish a rejection based on inherency, “the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” M.P.E.P. § 2112, (citing *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis original)). The Examiner’s statement that the smart card is inherently capable of transmitting the request through its output means and receiving the promotional data through its input means does not reasonably support a conclusion that the smart card actually can transmit and receive requests necessarily flows from the disclosure of the prior art. As such, Applicant asserts that this limitation of claim 41 has not been met.

The Office Action appears to assert that a database in *Narasimhan* “would inherently be accessible by the smart card when redeeming the coupon at the merchant device.” *See* Office Action at 15. However, this inherency argument provides no justification for the assertion that this claim limitation is allegedly taught by *Narasimhan*. Moreover, the Office Action appears to rely on a combination of *Narasimhan* and *Aggarwal* to allege that this limitation has been met (*see* Office Action at 15); however, the Office Action does not indicate how these references may be combined and does not show an apparent reason to combine the elements in the fashion claimed in claim 41. As such, the Examiner has not discharged his burden of making a *prima facie* case of obviousness with respect to claim 41. Thereof, this limitation of claim 41 has not been met.

Thereof, Claims 44-48 depend directly or indirectly from base claim 41 and thus inherit all limitations of base claim 41. However, each of these claims set forth features and limitations not recited by these references. Thus, Applicant respectfully asserts that for the above reasons, claims 44-48 are patentable over the rejection of record.

## 8. Independent Claim 49 and Related Dependent Claims

Independent claim 49 recites a method for consumer contact comprising, in part, “transmitting, to a mobile electronic device of a consumer, data relating to a promotion, wherein said promotion is generated from the profile of said consumer.” *Narasimhan* fails to teach or suggest this limitation. As previously discussed, data relating to a promotion is not transmitted to the smart card disclosed in *Narasimhan*. Rather, the user in *Narasimhan* reviews data relating to a promotion on his/her personal computer (*see, e.g.*, column 3, lines 9-16). When the user wishes to take advantage of a promotion, he/she requests a coupon associated with the promotion (*see, e.g.*, column 6, lines 30-36) and it is that coupon which may be saved to the smart card which has been physically associated with the personal computer via a smart card reader/writer (*see, e.g.*, column 7, lines 23-27). Thus, no data relating to a promotion is being transmitted to the smart card of *Narasimhan*. Accordingly, claim 49 should be deemed patentable over the rejection of record.

Claim 49 further recites “matching said promotion with a merchant profile in a merchant profile database when said consumer redeems said promotion by wirelessly communicating using said mobile electronic device in an electronic purchase.” *Narasimhan* fails to teach or suggest this limitation. A user does not redeem a promotion by wirelessly communicating using the smart card of *Narasimhan*. Rather, a user of the system set forth in *Narasimhan* redeems the promotion on his/her personal computer (*see, e.g.*, column 3, lines 9-16) by requesting a coupon associated with the promotion (*see, e.g.*, column 6, lines 30-36). That coupon is then saved to the smart card which has been physically associated with the personal computer via a smart card reader/writer (*see, e.g.*, column 7, lines 23-27). Even assuming *arguendo* a promotion may be saved on the smart card, a promotion still is not wirelessly redeemed with the smart card. Rather, the smart card is again physically associated with a smart card reader/writer, and the promotion would be extracted and redeemed via actions of the smart card reader/writer and/or the merchant device, not the smart card. Thus, a user of the smart card disclosed in *Narasimhan* is not redeeming a promotion by wirelessly communicating using the smart card in an electronic purchase. Accordingly, this limitation of claim 49 has not been met.

While the Examiner acknowledges that the Applicant has previously argued that at least this limitation of claim 49 has not been met, the Examiner has failed to acknowledge Applicant's arguments. *See* Office Action at 17-18. Specifically, the Office Action ignores Applicant's arguments concerning the portion of the claim limitation "when said consumer redeems said promotion by wirelessly communicating using said mobile electronic device in an electronic purchase." Moreover, while the Office Action refers to a combination of *Narasimhan* and *Aggarwal* as allegedly teaching this limitation at claim 49 (*see* Office Action at 18), the Office Action fails to assert where in *Aggarwal* this claim limitation is allegedly taught as it is not taught by *Narasimhan*. Thus, a *prima facie* case of obviousness with respect to the combination of applied references has not been established.

Claims 50 and 52-54 depend directly or indirectly from base claim 49 and thus inherit all limitations of base claim 49. However, each of these claims set forth features and limitations not recited by these references. Thus, Applicant respectfully asserts that for the above reasons, claims 50 and 52-54 are patentable over the rejection of record.

#### **9. Independent Claim 55 and Related Dependent Claims**

Independent claim 55 is directed to a mobile electronic device comprising, in part, "means for requesting data regarding a promotion from a remote server" and "means for receiving said data from said remote server." Applicant respectfully asserts that *Narasimhan* fails to teach these limitations. The Office Action acknowledges that the user in *Narasimhan* "requests the promotional data by logging in and walking through the hierarchical tree to select the desired promotional data (coupons) which are then stored in the database on the smart card." Accordingly, the user uses his/her personal computer to request data regarding a promotion from a remote server and does not use the smart card to make such a request. *See, e.g.*, column 3, lines 9-16; column 6, lines 30-36. The server sends a coupon to the user's personal computer, and the user saves that coupon to the smart card which has been physically associated with the personal computer via a smart card reader/writer (*see, e.g.*, column 7, lines 23-27). Accordingly, the smart card of *Narasimhan* does not receive data regarding a promotion from a remote server; rather, the smart card receives a coupon from the user's personal computer. Thus, these limitations of claim 55 have not been met.

Applicant again maintains that the smart card of *Narasimhan* is not a mobile electronic device as set forth in claim 55 as it is not capable of wirelessly transmitting or receiving data through a network. The Office Action states that “[i]t appears Applicant argues Narasimhan’s portable card device . . . with its card reader to download coupons to the card is not a wireless device and wireless transmission of data to the wireless device and wirelessly applying the promotion using the mobile electronic device arguably is not disclosed in Narasimhan.” Office Action at 6. The Office Action fails to challenge the statements in *Narasimhan* that the user of the smart card utilizes a smart card reader/writer to store coupons in a database on the smart card. *See, e.g.*, column 7, lines 23-27. As such, the coupons generated on a user’s computer are transmitted for storage on the smart card only when the smart card is *physically* associated with the smart card reader/writer and *not* through any wireless mechanism.

The Office Action asserts that even if the above is conceded, several references allegedly provide support for the above reasoning or Official Noticed facts taken earlier by Examiner Myhre. Office Action at 6. Applicant is not aware of any Official Noticed facts taken earlier by Examiner Myhre and is not aware of a procedure by which the current examiner can rely on statements made by a previous examiner in a prior office action as official notice in the absence of any documentary evidence.

Further, the references cited by the Examiner to allegedly evidence the level of skill in the art at the time of the invention are insufficient to teach at least this limitation of claim 55. The Office Action states that “[i]t is known at the time of invention that the following types of user devices or terminals, wired or mobile or wireless, can all be used interchangeably to receive/transfer data including incentives or coupons data” and cites several patents as allegedly supporting this assertion. Office Action at 6-7. However, the cited patents fail to teach at least a mobile device having “means for requesting data regarding a promotion from a remote server” or “means for receiving said data from said remote server” as recited in claim 55. For example, *Kolls* discusses use of a smart card reader/writer but does not address how such a reader/writer may be interchanged with wireless devices and networks as the Office Action suggests. Rather, Figure 4 of *Kolls* is described as having mutually exclusive control means. *See, e.g.*, column 9, lines 37-38. It does not suggest that the various control means are interchangeable as the Office Action implies. In any event, there is no teaching in



*Kolls* of a smart card and a smart card reader/writer being interchangeable with a wireless device nor is there any teaching of wirelessly transmitting data to such a combination or applying a promotion using such a combination. As such, *Kolls* does not evidence the level of skill in the art so as to allegedly support the Office Action's reasoning related to *Narasimhan* or the alleged Official Noticed facts.

Moreover, *Freeman* merely references downloading onto a chip card through a cellular device having a chip card communications port. *See, e.g.*, column 8, lines 24-31. The chip card is then inserted into the POS terminal to establish communication. *See, e.g.*, column 16, lines 9-12; column 17, lines 5-7. Thus, communication, for example, to apply a promotion is by electrical connection of the chip card to the POS terminal. No description is provided to allege that communication is made through wireless means. In addition, *Freeman* does not evidence the state of the art allegedly teaching wirelessly transmitting data relating to a promotion to a mobile electronic device or wirelessly applying a promotion to a purchase using a mobile electronic device.

In addition, the Office Action's reliance on *Aggarwal* fails to demonstrate that various user devices or terminals may be used interchangeably with the smart card of *Narasimhan*. The portion of *Aggarwal* cited in the Office Action describes later downloading coupons in a portable device but does not equate a smart card of the type set forth in *Narasimhan* as being interchangeable with other wireless devices as set forth in Applicant's claims.

The Office Action has not demonstrated that the above-referenced patents evidence the level of skill in the art at the time of the invention so as to support the assertion that the allegedly Official Noticed facts discharge the burden of showing *prima facie* obviousness. As such, Applicant asserts that *Leapfrog v. Fisher-Price* is not applicable. The Office Action has failed to show that the references allegedly provide support for the reasoning set forth in the Office Action or the alleged Official Noticed facts taken earlier by Examiner Myhre. Moreover, the Office Action has not demonstrated how the smart card of *Narasimhan* could allegedly be updated with "modern components" or how the "modern components" allegedly teach what is claimed by Applicant. As the references cited in the Office Action do not demonstrate the interchangeability of the smart card device of *Narasimhan* with other user devices, Applicant asserts that it would not have been obvious to replace the "unit including

the card interface of Narasimhan with a cell phone with chip card communications port as taught by Freeman or with a portable phone as taught in Aggarwal as the Office Action suggests. *See* Office Action at 9-10.

Further, while the Office Action alleges that it would have been obvious to incorporate the functionality of the smart card into other mobile devices (*see, e.g.*, Office Action at 7-10), Applicant respectfully disagrees. While the smart card may be carried around by the user, there is no teaching or suggestion set forth in the reference for incorporation of the smart card taught in *Narasimhan* into other mobile devices, and thus, the Examiner has not discharged the burden of showing *prima facie* obviousness. Thus, claim 55 should be deemed patentable over the rejection of record.

Moreover, the Examiner states that “it is a trend in the art for everybody to go mobile and do things on cellular phones/PDAs and the likes that used to be done in wired systems.” *See* Office Action at 7. From this statement, it appears that the Examiner is relying on impermissible hindsight in order to piece together the claim limitations. Thus, Applicant believes that the Examiner has either relied on his own personal knowledge, or taken Official Notice, with respect to this matter. Applicant is not aware of any reference contemporaneous with the filing of Applicant’s patent application that teaches of such a trend. Alternatively, such an assertion without documentary evidence may be appropriate if the Office Action provides “specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge.” M.P.E.P. § 2144.03(B) (citing *In re Soli*, 317 F.2d at 946, 37 USPQ at 801, and *In re Chevenard*, 139 F.2d at 713, 60 USPQ at 241). However, because the above-quoted statement is merely an assertion, rather than reasoning, the Official Notice must fail. Under Rule 37 C.F.R. § 1.104(d)(2), the Examiner is hereby requested to provide and make of record an affidavit setting forth his data as specifically as possible for the assertion. Alternatively, under M.P.E.P. § 2144.03, the Examiner is hereby requested to cite a reference in support of the assertion. Otherwise the rejection of claim 55 should be withdrawn.

Again, the Office Action suggests that Applicant has argued that “a mobile device including at least ‘means for applying received promotion when a purchase is made at a point of sale (POS)’ is not disclosed.” *See* Office Action at 12. The Office Action implies that

Applicant has previously argued that this limitation is allegedly not disclosed by *Narasimhan*. Rather, in the Amendment Accompanying Request for Continued Examination filed July 22, 2008, Applicant merely stated that the additional art referenced by the Examiner does not teach at least this step. *See* Amendment at 15. Regardless, the Office Action has not shown that this step of claim 55 is taught by *Narasimhan*. The Office Action alleges that Applicant's argument has been addressed in reference to Claim 41 below. *See* Office Action at 12. Applicant respectfully disagrees.

Claims 56-60 depend directly or indirectly from base claim 55 and thus inherit all limitations of base claim 55. However, each of these claims set forth features and limitations not recited by these references. For example, *Narasimhan* does not teach that the mobile electronic device is "a mobile telephone and the unique identification is the telephone number" as set forth in claim 58. The Office Action alleges that *Narasimhan* discloses utilizing an Internet or telephone interface. *See* Office Action at 21. However, *Narasimhan* addresses use of these interfaces to describe how the server may be connected to the user's personal computer, and *not* the form that the smart card may assume. Thus, Applicant respectfully asserts that for the above reasons, claims 56-60 are patentable over the rejection of record.

#### **10. Independent Claim 61 and Related Dependent Claims**

Claim 61 recites a system for redeeming promotions comprising, in part, "a wireless mobile electronic device associated with a particular consumer." *Narasimhan* fails to teach or suggest this limitation. The smart card of *Narasimhan* is not a wireless mobile electronic device. Rather, the smart card must be physically associated with the user's personal computer or with the merchant device by swiping or inserting it into a smart card reader/writer. *See, e.g.*, column 7, lines 20-31. As such, the smart card does not operate as a wireless mobile electronic device.

The Office Action states that "[i]t appears Applicant argues *Narasimhan*'s portable card device . . . with its card reader to download coupons to the card is not a wireless device and wireless transmission of data to the wireless device and wirelessly applying the promotion using the mobile electronic device arguably is not disclosed in *Narasimhan*."

Office Action at 6. The Office Action fails to challenge the statements in *Narasimhan* that the user of the smart card utilizes a smart card reader/writer to store coupons in a database on the smart card. *See, e.g.*, column 7, lines 23-27. As such, the coupons generated on a user's computer are transmitted for storage on the smart card only when the smart card is *physically* associated with the smart card reader/writer and *not* through any wireless mechanism.

The Office Action asserts that even if the above is conceded, several references allegedly provide support for the above reasoning or Official Noticed facts taken earlier by Examiner Myhre. Office Action at 6. Applicant is not aware of any Official Noticed facts taken earlier by Examiner Myhre and is not aware of a procedure by which the current examiner can rely on statements made by a previous examiner in a prior office action as official notice in the absence of any documentary evidence.

Further, the references cited by the Examiner to allegedly evidence the level of skill in the art at the time of the invention are insufficient to teach at least this limitation of claim 61. The Office Action states that “[i]t is known at the time of invention that the following types of user devices or terminals, wired or mobile or wireless, can all be used interchangeably to receive/transfer data including incentives or coupons data” and cites several patents as allegedly supporting this assertion. Office Action at 6-7. However, the cited patents fail to teach at least “means for receiving from said wireless mobile electronic device associated with said particular consumer an acceptance of said promotion” as recited in claim 61. For example, *Kolls* discusses use of a smart card reader/writer but does not address how such a reader/writer may be interchanged with wireless devices and networks as the Office Action suggests. Rather, Figure 4 of *Kolls* is described as having mutually exclusive control means. *See, e.g.*, column 9, lines 37-38. It does not suggest that the various control means are interchangeable as the Office Action implies. In any event, there is no teaching in *Kolls* of a smart card and a smart card reader/writer being a wireless device nor is there any teaching of wirelessly transmitting data to such a combination or applying a promotion using such a combination. As such, *Kolls* does not evidence the level of skill in the art so as to allegedly support the Office Action's reasoning related to *Narasimhan* or the alleged Official Noticed facts.

Moreover, *Freeman* merely references downloading onto a chip card through a cellular device having a chip card communications port. *See, e.g.*, column 8, lines 24-31. The chip card is then inserted into the POS terminal to establish communication. *See, e.g.*, column 16, lines 9-12; column 17, lines 5-7. Thus, communication, for example, to apply a promotion is by electrical connection of the chip card to the POS terminal. No description is provided to allege that communication is made through wireless means. In addition, *Freeman* does not evidence the state of the art allegedly teaching wirelessly transmitting data relating to a promotion to a mobile electronic device or wirelessly applying a promotion to a purchase using a mobile electronic device.

In addition, the Office Action's reliance on *Aggarwal* fails to demonstrate that various user devices or terminals may be used interchangeably with the smart card of *Narasimhan*. The portion of *Aggarwal* cited in the Office Action describes later downloading coupons in a portable device but does not equate a smart card of the type set forth in *Narasimhan* as being interchangeable with other wireless devices as set forth in Applicant's claims.

The Office Action has not demonstrated that the above-referenced patents evidence the level of skill in the art at the time of the invention so as to support the assertion that the allegedly Official Noticed facts discharge the burden of showing *prima facie* obviousness. As such, Applicant asserts that *Leapfrog v. Fisher-Price* is not applicable. The Office Action has failed to show that the references allegedly provide support for the reasoning set forth in the Office Action or the alleged Official Noticed facts taken earlier by Examiner Myhre. Moreover, the Office Action has not demonstrated how the smart card of *Narasimhan* could allegedly be updated with "modern components" or how the "modern components" allegedly teach what is claimed by Applicant. As the references cited in the Office Action do not demonstrate the interchangeability of the smart card device of *Narasimhan* with other user devices, Applicant asserts that it would not have been obvious to replace the "unit including the card interface of *Narasimhan* with a cell phone with chip card communications port as taught by *Freeman* or with a portable phone as taught in *Aggarwal* as the Office Action suggests. *See* Office Action at 9-10.

Further, while the Office Action alleges that it would have been obvious to incorporate the functionality of the smart card into other mobile devices (*see, e.g.*, Office

Action at 7-10), Applicant respectfully disagrees. While the smart card may be carried around by the user, there is no teaching or suggestion set forth in the reference for incorporation of the smart card taught in *Narasimhan* into other mobile devices, and thus, the Examiner has not discharged the burden of showing *prima facie* obviousness. Thus, claim 61 should be deemed patentable over the rejection of record.

Moreover, the Examiner states that “it is a trend in the art for everybody to go mobile and do things on cellular phones/PDAs and the likes that used to be done in wired systems.” *See* Office Action at 7. From this statement, it appears that the Examiner is relying on impermissible hindsight in order to piece together the claim limitations. Thus, Applicant believes that the Examiner has either relied on his own personal knowledge, or taken Official Notice, with respect to this matter. Applicant is not aware of any reference contemporaneous with the filing of Applicant’s patent application that teaches of such a trend. Alternatively, such an assertion without documentary evidence may be appropriate if the Office Action provides “specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge.” M.P.E.P. § 2144.03(B) (citing *In re Soli*, 317 F.2d at 946, 37 USPQ at 801, and *In re Chevenard*, 139 F.2d at 713, 60 USPQ at 241). However, because the above-quoted statement is merely an assertion, rather than reasoning, the Official Notice must fail. Under Rule 37 C.F.R. § 1.104(d)(2), the Examiner is hereby requested to provide and make of record an affidavit setting forth his data as specifically as possible for the assertion. Alternatively, under M.P.E.P. § 2144.03, the Examiner is hereby requested to cite a reference in support of the assertion. Otherwise the rejection of claim 61 should be withdrawn.

Further, claim 61 recites “means for receiving from said wireless mobile electronic device associated with said particular consumer an acceptance of said promotion.” *Narasimhan* fails to teach or suggest this limitation. Even assuming *arguendo* that the smart card of *Narasimhan* is a wireless mobile electronic device, the smart card does not contain any mechanism to wirelessly transmit acceptance of a promotion from the smart card. *See, e.g.*, column 7, lines 10-31. The Office Action asserts that “Examiner Myhre had emphasized earlier that the Examiner considers the selection by the consumer, in *Narasimhan*, of the desired coupons as being an acceptance thereof.” *See* Office Action at 12. Applicant respectfully disagrees. While the consumer in *Narasimhan* may select a desired coupon, such

a selection indicating alleged acceptance of the promotion, is not received from a wireless mobile electronic device. Rather, the user in *Narasimhan* clips the coupon while sitting at his/her personal computer and stores the coupon in a database on the smart card by employing a smart card reader/writer. *See, e.g.*, column 7, lines 23-27. The Office Action also appears to refer to the combination of *Narasimhan* and *Aggarwal* as allegedly meeting this limitation. *See* Office Action at 12. However, the Office Action has not stated any basis for alleging that this combination of applied references teaches at least this limitation of claim 61 and has not discharged the burden of making a *prima facie* showing of obviousness. Thus, this limitation of claim 61 has not been met.

Claims 62-63 and 65 depend directly or indirectly from base claim 61 and thus inherit all limitations of base claim 61. However, each of these claims set forth features and limitations not recited by the references. For example, claim 63 recites “means operable in response to communications from said wireless mobile electronic device for coordinating payment for said associated transaction.” *Narasimhan* fails to teach or suggest this limitation. The Office Action alleges that *Narasimhan* discloses “redeeming the promotion at a point of sale (POS) terminal (merchant device) using a payment method controlled by the consumer’s mobile electronic device (credit card).” Office Action at 20. However, the smart card of *Narasimhan* does not send communications for the system to respond to for coordinating payment for an associated transaction, and the Office Action fails to address this limitation of claim 63. Rather, the smart card of *Narasimhan* merely acts as a traditional credit or debit card for payment purposes. *See, e.g.*, column 7, lines 50-59. Thus, Applicant respectfully asserts that for the above reasons, claims 62-63 and 65 are patentable over the rejection of record.

#### **11. Independent Claim 66 and Related Dependent Claims**

Independent claim 66 recites a system for coordinating transactions comprising, in part, “means for coordinating said received information from a wireless mobile electronic device of a specific one of said users with information available to said server pertaining to said unique merchant location.” *Narasimhan* fails to teach or suggest this limitation. The smart card of *Narasimhan* is not a wireless mobile electronic device. Further, the system in *Narasimhan* does not receive information specific to one of many merchants directly from

the smart card. Rather, a smart card reader/writer must be connected to the merchant device and the smart card swiped or inserted into the smart card reader/writer to allow the merchant device to communicate to the server information about, for example, the POS location of the merchant. *See, e.g.*, column 7, lines 27-37. Thus, information is not received from the smart card and coordinated with information available to said server pertaining to said unique merchant location. Accordingly, this limitation of claim 66 has not been met.

Claim 66 further recites “means for communicating at least a portion of said coordinated information to said wireless mobile electronic device of said one user over said temporarily established connection, said coordinated information including promotional information associated with said specific user.” *Narasimhan* fails to teach or suggest this limitation. The system of *Narasimhan* does not include means to communicate coordinated information including promotional information associated with the specific user to the smart card. Rather, promotional information is saved onto the smart card which is physically associated with the user’s personal computer through a smart card reader/writer when the user receives the promotional information on his/her personal computer. *See, e.g.*, column 6, lines 30-57; column 7, lines 10-31. Accordingly, independent claim 66 should be deemed patentable over the rejection of record.

Claims 67-69 depend directly or indirectly from base claim 66 and thus inherit all limitations of base claim 66. Each of these claims set forth features and limitations not recited by these references. For example, claim 68 recites “means at said server for accepting further information from said wireless mobile electronic device of said one user, said further information comprising acceptance information for both said cost information and said promotion information.” *Narasimhan* fails to teach or suggest this limitation as the smart card does not send further information including acceptance information to means at the server. Rather, it is the merchant device that communicates information such as acceptance information to the server. *See, e.g.*, column 7, lines 32-37. Similarly, claim 69 recites “means at said server for coordinating payment to said one merchant from said one user, said payment based upon said information communicated to said wireless mobile electronic device of said user and said acceptance information from said wireless mobile electronic device of said user. However, *Narasimhan* fails to teach or suggest this limitation as payment is not coordinated based on information sent from the smart card to the server but



rather based on information transmitted from the merchant device. *See, e.g.*, column 7, lines 32-37. Thus, Applicant respectfully asserts that for the above reasons, claims 67-69 are patentable over the rejection of record.

## **12. Independent Claim 70 and Related Dependent Claims**

Independent claim 70 recites a method for coordinating transactions comprising, in part, “coordinating said received information from said wireless mobile electronic device specific one of said users with available information pertaining to said unique merchant location.” *Narasimhan* fails to teach or suggest this limitation. The smart card of *Narasimhan* is not a wireless mobile electronic device. Further, the system in *Narasimhan* does not receive information specific to one of many merchants directly from the smart card. Rather, a smart card reader/writer must be connected to the merchant device to allow the merchant device to communicate to the server information about, for example, the POS location of the merchant. *See, e.g.*, column 7, lines 27-37. Thus, information is not received from the smart card and coordinated with information available to said server pertaining to said unique merchant location. Thus, this limitation of claim 70 has not been met.

Independent claim 70 further recites “communicating at least a portion of said coordinated information to said wireless mobile electronic device of said one user over said temporarily established wireless communication connection, said coordinated information including promotions available to said specific one of said users pertaining to said obtained merchandise.” *Narasimhan* fails to teach or suggest this limitation. The system of *Narasimhan* does not communicate coordinated information including promotional information associated with the specific user to the smart card. Rather, promotional information is saved onto the smart card which is physically associated with the user’s personal computer through a smart card reader/writer when the user receives the promotional information on his/her personal computer. *See, e.g.*, column 6, lines 30-57; column 7, lines 10-31. Accordingly, independent claim 70 should be deemed patentable over the rejection of record.

The Office Action suggests that Applicant has previously presented arguments that the limitation of “accepting over a temporarily established communication connection from a

wireless mobile electronic device of any one of a plurality of users information specific to one of many merchants, said information including data specific to a unique location of one of said merchants, said specific data pertaining to merchandise obtained from said merchant” is not disclosed in *Narasimhan*. See Office Action at 18-19. Applicant respectfully disagrees as Applicant did not previously present this argument with respect to *Narasimhan*. Rather, in the Amendment Accompanying Request for Continued Examination filed July 22, 2008, Applicant merely stated that the additional art referenced by the Examiner does not teach at least this step. See Amendment at 15-16. Regardless, the Office Action has not shown that this step of claim 70 is taught by *Narasimhan*. More specifically, the smart card of *Narasimhan* does not send any one of a plurality of users information specific to one of many merchants over a temporarily established wireless communication connection. Rather, the user clips the coupon while sitting at his/her personal computer and stores the coupon in a database on the smart card by employing a smart card reader/writer. See, e.g., column 7, lines 23-27. Thus, this limitation of claim 70 is not taught by *Narasimhan*.

The Office Action also appears to assert that the combination of *Narasimhan* and *Aggarwal* allegedly teaches this limitation of claim 70. See Office Action at 18. However, the Office Action fails to set forth a *prima facie* case of obviousness as no reasons are provided for asserting that this combination of applied references allegedly teaches this limitation of claim 70.

Claims 71-73 depend directly or indirectly from base claim 70 and thus inherit all limitations of base claim 70. Each of these claims set forth features and limitations not recited by these references. For example, claim 72 recites “accepting further information from said wireless mobile electronic device of said one user, said further information comprising acceptance information for said cost information and for said promotion.” *Narasimhan* fails to teach or suggest this limitation as the smart card does not send further information including acceptance information to the system. Rather, the merchant device communicates any information to the server. See, e.g., column 7, lines 32-37. Similarly, claim 73 recites “coordinating payment to said one merchant from said one user, said payment based upon said information communicated to said wireless mobile electronic device of said user and said acceptance information from said wireless mobile electronic device of said user, including acceptance or rejection of said promotion.” However,

*Narasimhan* fails to teach or suggest this limitation as payment is not coordinated based on information sent from the smart card to the server but rather based on information transmitted from the merchant device. *See, e.g.*, column 7, lines 32-37. Thus, Applicant respectfully asserts that for the above reasons, claims 71-73 are patentable over the rejection of record.

#### IV. Conclusion

In view of the above, Applicant believes the pending application is in condition for allowance. Applicant believes there is a one month extension of time fee due with this response. This fee will be paid by Credit Card. Please charge any additional fees required or credit any overpayment during the pendency of this Application pursuant to 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees to Deposit Account No. 06-2380, under Order No. 65003/P002US/10312242 from which the undersigned is authorized to draw.

Dated: February 17, 2009

Respectfully submitted,

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